

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

KENNETH A. BARTON and MICHAEL J. MILLER,
(U.S. Application 07/827,906)

(Barton),

or

DAVID A. FISCHHOFF and FREDERICK J. PERLAK,
(U.S. Application 08/434,105)

Junior Party (Fischhoff),

v.

MICHAEL J. ADANG, THOMAS A. ROCHELEAU,
DONALD J. MERLO and ELIZABETH E. MURRAY,
(U.S. Patent 5,380,831)

Senior Party (Adang)

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DECISION AND ORDER ON PROPOSED PRELIMINARY
AND MISCELLANEOUS MOTIONS AND REQUESTS

TEDDY S. GRON, Administrative Patent Judge.

1. Background

September 26, 1983 - Michael J. Adang and John D. Kemp filed U.S. Application 06/535,354, entitled "Insect Resistant Plants" (assignment to Agrigenetics Research Associates Ltd. recorded September 20, 1983; assignment to Lubrizol Genetics Inc. recorded May 29 1986), now abandoned.

April 4, 1986 - Michael J. Adang and John D. Kemp filed U.S. Application 06/848,733, entitled "Insect Resistant Plants" (assignment to Lubrizol Genetics Inc. recorded June 25, 1986), now abandoned, which is claimed to be a continuation-in-part of U.S. Application 06/535,354, filed September 26, 1983.

September 9, 1988 - Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray filed U.S. Application 07/242,482, entitled "Synthetic Insecticidal Crystal Protein Gene" (assignment to Lubrizol Genetics Inc. recorded October 24, 1988), now abandoned, which is claimed to be a continuation-in-part of U.S. Application 06/848,733, filed April 4, 1986.

February 24, 1989 - David A. Fischhoff and Frederick J. Perlak filed U.S. Application 07/315,355, entitled "Synthetic Plant Genes And Method For Preparation" (assignment to Monsanto

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Company recorded February 24, 1989), now abandoned.

August 7, 1989 - Kenneth A. Barton and Michael J. Miller filed U.S. Application 07/390,561, entitled "Expression of Genes In Plants" (assignment to Agracetus recorded August 7, 1989; assignment to Monsanto Company recorded October 15, 1996), now abandoned.

February 12, 1990 - David A. Fischhoff and Frederick J. Perlak filed U.S. Application 07/476,661, entitled "Synthetic Plant Genes And Method For Preparation" (assignment to Monsanto Company recorded February 12, 1990), now abandoned, which is claimed to be a continuation-in-part of U.S. Application 07/315,355, filed February 24, 1989.

January 28, 1992 - Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray filed U.S. Application 07/827,844, entitled "Synthetic Insecticidal Crystal Protein Gene" (assignment to Mycogen Plant Science, Inc., recorded April 1, 1993), now abandoned, which is claimed to be a continuation-in-part of U.S. Application 07/242,482, filed September 9, 1988.

January 30, 1992 - Kenneth A. Barton and Michael J. Miller filed involved U.S. Application 07/827,906, entitled "Improved Expression of Genes In Plants" (assignment to Monsanto Company recorded October 15, 1996; assignment to Monsanto Technology LLC

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recorded June 13, 2001), which is claimed to be a continuation of U.S. Application 07/390,561, filed August 7, 1989.

October 9, 1992 - David A. Fischhoff and Frederick J. Perlak filed U.S. Application 07/959,506, entitled "Synthetic Plant Genes" (assignment to Monsanto Technology LLC recorded June 13, 2001), which is claimed to be a continuation of U.S. Application 07/476,661, filed February 12, 1990.

May 3, 1993 - Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray filed U.S. Application 08/057,191, entitled "Synthetic Insecticidal Crystal Protein Gene" (assignment to Mycogen Plant Science, Inc., recorded April 1, 1993), which is claimed to be a continuation of U.S. Application 07/827,844, filed January 28, 1992.

January 6, 1995 - Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray filed U.S. Application 08/369,839, entitled "Synthetic Insecticidal Crystal Protein Gene," which is claimed to be a division of 08/057,191, filed May 3, 1993.

January 6, 1995 - Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray filed U.S. Application 08/369,835, entitled "Synthetic Insecticidal Crystal Protein Gene" (assignment to Mycogen Plant Science, Inc., recorded

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April 1, 1993), which is claimed to be a continuation-in-part of 08/057,191, filed May 3, 1993.

January 10, 1995 - involved U.S. Patent 5,380,831 issued from Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray, U.S. Application 08/057,191, filed May 3, 1993.

May 3, 1995 - David A. Fischhoff and Frederick J. Perlak, filed involved U.S. Application 08/434,105 entitled "Synthetic Plant Genes And Method For Preparation" (assignment to Monsanto Technology LLC recorded June 13, 2001), which is claimed to be a divisional of U.S. Application 07/959,506, filed October 9, 1992.

May 19, 1996 - U.S. Patent 5,500,365 issued from David A. Fischhoff and Frederick J. Perlak, U.S. Application 07/959,506, filed October 9, 1992.

August 29, 1996 - Michael J. Adang and Elizabeth E. Murray filed U.S. Application 08/705,438, entitled "Synthetic Insecticidal Crystal Protein Gene Having A Modified Frequency Of Codon Usage" (assigned to Mycogen Plant Science, Inc.), which is claimed to be a division of U.S. Application 08/369,835, filed January 6, 1995 (now U.S. Patent 5,567,600), which is claimed to be a continuation-in-part of U.S. Application 08/057,191, filed May 3, 1993 (now U.S. Patent 5,380,831), which is claimed to be a continuation of U.S. Application 07/827,844, filed January 28,

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1992, which is claimed to be a continuation-in-part of U.S. Application 07/242,482, filed September 9, 1988.

August 29, 1996 - Michael J. Adang and Elizabeth E. Murray filed U.S. Application 08/704,966, entitled "Transgenic Plants Comprising Synthetic Insecticidal Crystal Protein Gene Having A Modified Frequency Of Codon Usage" (assigned to Mycogen Plant Science, Inc.), which is claimed to be a division of U.S. Application 08/369,839, filed January 6, 1995 (now U.S. Patent 5,567,862), which is claimed to be a continuation-in-part of 08/057,191, filed May 3, 1993 (now U.S. Patent 5,380,831), which is claimed to be a continuation of U.S. Application 07/827,844, filed January 28, 1992, which is claimed to be a continuation-in-part of U.S. Application 07/242,482, filed September 9, 1988.

October 22, 1996 - U.S. Patent 5,567,600 issued from Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray, U.S. Application 08/369,835, filed June 6, 1995, including a disclaimer of the terminal portion of the patent extending beyond the expiration date of U.S. Patent 5,380,831.

October 22, 1996 - U.S. Patent 5,567,862 issued from Michael J. Adang, Thomas A Rocheleau, Donald J. Merlo and Elizabeth E. Murray, U.S. Application 08/369,839, filed June 6, 1995.

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November 7, 1996 - Interference 103,781 was declared essentially as follows (Paper No. 2):

JUNIOR PARTY APPLICATION

Named Inventors: Kenneth A. Barton and Michael J. Miller

Application: Application 07/827,906, filed January 30, 1992

Title: Improved Expression of Genes in Plants

Assignee: None (assignment to Monsanto Company recorded October 15, 1996; assignment to Monsanto Technology LLC recorded June 13, 2001)

Accorded benefit for the purpose of priority of: Application 07/390,561, filed August 7, 1989

JUNIOR PARTY APPLICATION

Named Inventors: David A. Fischhoff and Frederick J. Perlak

Application: Application 08/434,105, filed May 3, 1995

Title: Synthetic Plant Genes and Method for Preparation

Assignee: None (assignment to Monsanto Technology LLC recorded June 13, 2001)

Accorded benefit for the purpose of priority of: Application 07/959,506, filed October 9, 1992, now U.S. Patent 5,500,365, issued March 3, 1996; Application 07/476,661, filed February 12, 1990, now abandoned; and Application 07/315,355, filed February 24, 1989, now abandoned

SENIOR PARTY PATENT

Named Inventors: Michael J. Adang, Thomas A. Rocheleau,
Donald J. Merlo and Elizabeth E. Murray

Application: Application 08/057,191, filed May 3,
1993, now U.S. Patent 5,380,831, issued
January 10, 1995

Title: Synthetic Insecticidal Crystal Protein
Gene

Assignee: Mycogen Plant Science, Inc. (Paper
No. 13)

Accorded benefit
for the purpose of
priority of: Applications 07/827,844, filed
January 28, 1992, now abandoned,
and Application 07/242,482, filed
September 9, 1988, now abandoned

Count 1

A method of designing a synthetic Bacillus
thuringiensis gene to be more highly expressed in plants,
comprising the steps of:

a) analyzing the coding sequence of a gene derived
from Bacillus thuringiensis which encodes an insecticidal
protein toxin, and modifying a portion of said coding
sequence to yield a modified sequence which contains a
greater number of codons preferred by the intended plant
host than did said coding sequence, or

b) analyzing the coding sequence of a gene derived
from Bacillus thuringiensis which encodes an insecticidal
protein toxin, and modifying a portion of said coding
sequence to yield a modified sequence which contains a
greater number of codons preferred by the intended plant
host than did said coding sequence and fewer plant
polyadenylation signals than said coding sequence.

The claims of the parties which correspond to this
count are:

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Barton et al.: Claims 1-4, 7, and 15-22

Fischhoff et al.: Claims 3, 5, and 39-43

Adang et al.: Claims 1-14.

December 12, 1996 - An administrative patent judge (APJ) entered an Order to Show Cause stating (Paper No. 11, pp. 1-2, bridging para.):

In view of the common ownership by Monsanto Company of the Barton application and the Fischhoff application, the junior party Barton is ordered to show cause why judgement should not be entered against him within 30 days from the date of this order. Monsanto Company, as the assignee of both Barton and Fischhoff, may name the prior inventor in response to this order. Cf. M.P.E.P. 2302.

January 17, 1997 - The APJ ordered Monsanto Company "to name the prior inventor of count 1 In the event Monsanto makes no election, judgment will be entered against junior party Barton" (Paper No. 29, p. 3).

February 3, 1997 - Junior Party Barton et al. (hereafter Barton) petitioned the Commissioner under 37 CFR § 1.644(a)(1) to reverse or postpone the APJ's January 17, 1997 order (Paper No. 35).

March 26, 1997 - Barton's February 3, 1997, petition was denied (Paper No. 38).

June 19, 1997 - The Board of Patent Appeals and Interferences (Board) entered the following judgment (Paper No. 53):

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Whereas Monsanto, the common assignee of the Barton et al. and Fischhoff et al. applications has named the party Fischhoff et al. as the prior inventor of count 1, pursuant to 37 CFR 1.602(a) and 1.610(e) judgement is hereby entered against Barton et al. as to the subject matter of count 1. Accordingly, Kenneth A. Barton and Michael J. Miller are not entitled to a patent containing Claims 1-4, 7, and 15-22 corresponding to count 1. The interference will continue as Fischhoff et al. v. Adang et al.

June 27, 1997 - Barton filed notice under 35 U.S.C. §§ 141 and 142 of appeal to the U.S. Court of Appeals for the Federal Circuit from the judgment of the Board of Patent Appeals and Interferences entered June 17, 1997 (Paper No. 55).

February 5, 1998 - The U.S. District Court for the District of Delaware entered a judgment (Mycogen Plant Science, Inc. v. Monsanto Co., No. 96-505 (D. Del. Feb. 5, 1998)) in a suit brought by Mycogen Plant Science, Inc., and Agrigenetics Inc. against Monsanto Co., DeKalb Genetics Corp., and Delta and Pine Land Co. for infringement of two Mycogen patents (Adang et al., U.S. Patent 5,567,862, entitled "Synthetic Insecticidal Crystal Protein Gene," which issued October 22, 1996, from U.S. Application 08/369,839, filed January 6, 1995, and Adang et al., U.S. Patent 5,567,600, entitled "Synthetic Insecticidal Crystal Protein Gene," which issued October 22, 1996, from U.S. Application 08/369,835, filed January 6, 1995). A jury rendered a verdict that (1) defendants' products did not literally infringe any of the contested claims of Mycogen's patents, and

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(2) all of the contested claims of Mycogen's patents are invalid because Monsanto invented the subject matter thereof before the priority dates of Mycogen's patents. See the Procedural History in Mycogen Plant Sci., Inc. v. Monsanto Co., 243 F.3d 1316, 1320-1321, 58 USPQ2d 1030, 1033-1034 (Fed. Cir. 2001) (Paper No. 125).

December 9, 1998 - The Court of Appeals for the Federal Circuit reversed the Board's June 19, 1997, judgment and remanded (Paper No. 124). Barton v. Adang, 162 F.3d 1140, 49 USPQ2d 1128 (Fed. Cir. 1998) (Paper No. 118, Exhibit A).

September 8, 1999 - The U.S. District Court for the District of Delaware entered a revised order (Paper No. 125, Exh. H) and ruling on post-trial motions (Paper No. 125, Exh. I) (Mycogen Plant Sci., Inc. v. Monsanto Co., 61 F.2d 199 (D. Del. 1999)) which "granted Mycogen's motion for JMOL that Monsanto's processes and resulting products infringed . . . the '600 and '862 patents." Mycogen Plant Sci., Inc. v. Monsanto Co., 243 F.3d at 1320, 58 USPQ2d at 1034 (Paper No. 146).

The district court also denied Mycogen's motion for JMOL requesting the court to set aside the jury's finding of anticipation due to prior invention by Monsanto.

The district court granted Monsanto's motion for JMOL holding that the claims of the '600 and '862 patents were invalid for lack of enablement pursuant to 35 U.S.C. § 112. . . .

Id. at 1321, 58 USPQ2d at 1034 (Paper No. 146).

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November 10, 1999 - In a suit brought by Mycogen Plant Science, Inc. and Agrigenetics Inc. against Monsanto Company for infringement of plaintiff's patent (Adang et al., U.S. Patent 5,380,831, issued January 10, 1995, from U.S. Application 08/057,191, filed May 3, 1993), the U.S. District Court for the Southern District of California entered an order (Mycogen Plant Sci., Inc. v. Monsanto Co., No. 95-CV-653 (S.D. Cal. Nov. 10, 1999) (Paper No. 127, Exh. A) which granted defendant's motion for summary judgment that Claims 1-12 of Mycogen's '831 patent are invalid under 35 U.S.C. § 102(g) and/or § 103 because Monsanto invented the subject matter thereof before Mycogen, as determined by the U.S. District Court for the District of Delaware in Mycogen Plant Sci., Inc. v. Monsanto Co., 61 F. Supp.2d 199 (D. Del. 1999), which was affirmed in Mycogen Plant Sci., Inc. v. Monsanto Inc., 243 F.3d 1316, 58 USPQ2d 1030 (Fed. Cir. 2001), and denied defendant's motion for summary judgment that the contested claims of Mycogen's '831 patent are invalid for noncompliance with the enablement requirement of the first paragraph of 35 U.S.C. § 112 as moot (Paper No. 127, Exh. A).

January 18, 2000 - U.S. Patent 6,015,891 issued from Adang et al., U.S. Application 08/705,438, filed August 29, 1996, subject to disclaimers of its term extending beyond the statutory expiration dates of Adang et al., U.S. Patent 5,567,600, issued

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October 22, 1996, and Adang et al., U.S. Patent 5,380,831, issued January 10, 1995.¹

January 18, 2000 - U.S. Patent 6,013,523 issued from Adang et al., U.S. Application 08/704,966, filed August 29, 1996, subject to a disclaimer of its term extending beyond the statutory expiration date of Adang et al., U.S. Patent 5,567,862, issued October 22, 1996.

March 12, 2001 - On appeal from the decision of the U.S. District Court for the District of Delaware in Mycogen Plant

But for prior issued patents identified in the terminal disclaimers entered as Paper No. 23 in U.S. Patent 6,015,891 and Paper No. 25 in U.S. Patent 6,013,523, both disclaimers read:

The owner of 100% interest in the instant application, Mycogen Plant Science, Inc., hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 for U.S. Patent No . . . issued on

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent No . . . in the event that any of the . . . patents: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

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Sci., Inc. v. Monsanto Co., 61 F. Supp.2d 199 (D. Del. 1999), the U.S. Court of Appeals for the Federal Circuit:

. . . affirm[ed] the verdict of noninfringement based on patent invalidity due to prior invention pursuant to 35 U.S.C. § 102(g). This makes it unnecessary to address the finding of lack of enablement pursuant to 35 U.S.C. § 112.

Mycogen Plant Sci., Inc. v. Monsanto Co., 243 F.3d at 1320, 58 USPQ2d at 1033 (Paper No. 146).

May 30, 2001 - On appeal from the decision of the U.S. District Court for the Southern District of California in Mycogen Plant Sci., Inc. v. Monsanto Co., No. 95-CV-653 (S.D. Cal. Nov. 10, 1999) (Paper No. 127, Exh. A), the U.S. Court of Appeals for the Federal Circuit affirmed-in-part, reversed-in-part, and remanded. Mycogen Plant Sci., Inc. v. Monsanto Co., 252 F.3d 1306, 1309-1310, 58 USPQ2d 1891, 1892-1893 (Fed. Cir. 2001).

The Federal Circuit concluded at 1309, 58 USPQ2d at 1893, that:

. . . the district court improperly resolved disputed questions of material fact pertaining to the issue of prior invention, and we therefore reverse the court's ruling on summary judgment that the '831 patent is invalid under 35 U.S.C. § 102(g). We decline to affirm the summary judgment of invalidity on the alternative ground of non-enablement, as urged by Monsanto, but leave to the district court the task of determining in the first instance whether there is a genuine issue of material fact as to enablement based on its assessment of the evidence presented to it in the summary judgment proceeding.

Id. at 1310, 58 USPQ2d at 1894, the Federal Circuit explained:

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We agree with the district court that collateral estoppel requires the court to conclude that Monsanto reduced the invention [claimed in the Mycogen's '831 patent] to practice before Mycogen, and that collateral estoppel does not resolve the question whether Mycogen was the first to conceive and then was diligent during the critical period. On the merits of the summary judgment question, however, we do not agree that Monsanto has met its burden of showing that there are no issues of material fact regarding whether Mycogen was the first to conceive the invention and then diligently reduce it to practice.

September 4, 2002 - An Administrative Patent Judge (APJ) entered a Decision and Order On Preliminary and Miscellaneous Motions and Requests (Paper No. 148):

denying Adang's Preliminary Motion 1 (Paper No. 45) under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by substituting Proposed Count 2 for existing Count 1;

dismissing Adang's Preliminary Motion 2 (Paper No. 46) under 37 CFR § 1.633(f) for benefit of the January 28, 1992, filing date of U.S. Application 07/827,844, and the September 9, 1988, filing date of U.S. Application 07/242,482, for Proposed Count 2;

denying Adang's Contingent Preliminary Motion 3 (Paper No. 47) under 37 CFR § 1.633(a) for judgment that Claims 3, 5, and 39-43 of Fischhoff's involved U.S. Application 08/434,105, filed May 3, 1995, designated as corresponding to the interference count, are unpatentable under 35 U.S.C. § 102(g) over at least one claim of Barton's U.S. Application 07/827,906, filed January 30, 1992, designated as corresponding to the count,

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or under 35 U.S.C. § 103 in view of prior art including at least one claim of Barton's U.S. Application 07/827,906, filed January 30, 1992, designated as corresponding to the count. Adang's motion had presumed that Barton had been determined to be, or Monsanto Technology LLC (Monsanto), the assignee of Fischhoff's and Barton's involved applications, had designated Barton as first to invent the subject matter defined by Count 1 as between Fischhoff and Barton.

denying Adang's contingent request (Paper No. 47) for permission to seek deposition and documentary discovery relevant to Monsanto's presumed determination and/or election of Barton as first to invent the subject matter defined by the count as between Fischhoff and Barton;

dismissing Fischhoff's request (Paper No. 78) that the APJ exercise its discretion under 37 CFR § 1.642 to add commonly assigned Adang et al., U.S. Patent 5,567,600 (Fischhoff Exhibit 37 (FX 37)), issued October 22, 1996, to this interference, designate all twenty-four claims thereof as corresponding to the count, and set an additional preliminary motion period for the parties to file motions relative to the newly added patent;

dismissing Fischhoff's request (Paper No. 79) that the APJ exercise his discretion under 37 CFR § 1.642 to add commonly

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assigned Adang et al., U.S. Patent 5,567,862 (FX 3), issued October 22, 1996, to this interference, designate all twenty-four claims thereof as corresponding to the count, and set an additional preliminary motion period for the parties to file motions relative to the newly added patent;

denying Fischhoff's Preliminary Motion 3 (Paper No. 80) under 37 CFR § 1.633(a) for judgment that Claims 1-12 of Adang's U.S. Patent 5,380,831 (FX 11), issued January 10, 1995, are unpatentable under 35 U.S.C. § 112, second paragraph;

denying Fischhoff's Preliminary Motion 4 (Paper No. 81) under 37 CFR § 1.633(c)(1) to redefine the subject matter of this interference by substituting any one of Fischhoff's Proposed Counts 2, 3 and 4 for original Count 1;

deferring to final hearing Fischhoff's Preliminary Motion 5 (Paper No. 82) under 37 CFR § 1.633(a) for judgment that Claims 1-12 of Adang's U.S. Patent 5,380,831 (FX 11), issued January 10, 1995, are unpatentable under 35 U.S.C. § 112, first paragraph (enablement requirement);

granting Adang's motion under 37 CFR § 1.635 (Paper No. 116) for an order implementing the decision in Barton v. Adang, 162 F.3d 1140, 49 USPQ2d 1128 (Fed. Cir. 1998) (Paper No. 118, Exhibit A);

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denying Fischhoff's Preliminary Motion 6 (Paper No. 83) under 37 CFR § 1.633(c)(2) to redefine the subject matter of the interference by adding proposed Claims 44 and 45 to Fischhoff's involved U.S. Application 08/434,105, filed May 3, 1995 (Paper No. 84), and designating the new claims as corresponding to the count;

deferring to final hearing Fischhoff's Preliminary Motion 7 (Paper No. 85) under 37 CFR § 1.633(a) for judgment that Claims 1-12 of Adang's U.S. Patent 5,380,831 (FX 11), issued January 10, 1995, are unpatentable under 35 U.S.C. § 102 or § 103;

dismissing Fischhoff's Preliminary Motion 8 (Paper No. 86) under 37 CFR § 1.633(f) to be accorded benefit of the October 9, 1992, filing date of Fischhoff's U.S. Application 07/959,506; the February 12, 1990, filing date of Fischhoff's U.S. Application 07/476,661; and the February 24, 1989, filing date of U.S. Application 07/315,355, for Fischhoff's Proposed Counts 2, 3, and 4 (Fischhoff's Preliminary Motion 4, Paper No. 81);

denying Fischhoff's Preliminary Motion 9 (Paper No. 87) under 37 CFR § 1.633(a) for judgment that Claims 1-12 of Adang et al., U.S. Patent 5,380,831, issued January 10, 1995, are unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement);

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deferring to final hearing Fischhoff's Preliminary Motion No. 10 (Paper No. 88) under 37 CFR § 1.633(c)(4) to redefine the subject matter of the interference by designating

(1) Claims 41-43 of Fischhoff's involved U.S. Application 08/434,105, filed May 3, 1995, and (2) Claims 13-14 of Adang's U.S. Patent 5,380,831 (FX 11), issued January 10, 1995, as not corresponding to the count;

dismissing Fischhoff's Preliminary Motion 11 (Paper No. 89) under 37 CFR § 1.633(c)(2), contingent on granting Fischhoff's Second 37 CFR § 642 Request (Paper No. 79), to redefine the subject matter of the interference by adding proposed Claims 46 to Fischhoff's involved U.S. Application 08/434,105, filed May 3, 1995 (Paper No. 90), and designating the new claim as corresponding to the count;

dismissing Fischhoff's Preliminary Motion 12 (Paper No. 60) under 37 CFR § 1.633(f), contingent upon the granting of Adang's Preliminary Motion 1 (Paper No. 45), for benefit of the October 9, 1992, filing date of Fischhoff's U.S. Application 07/959,506, the February 12, 1990, filing date of Fischhoff's U.S. Application 07/476,661, and the February 25, 1989, filing date of Fischhoff's U.S. Application 07/315,355, for subject matter defined by Adang's Proposed Substitute Count 2;

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denying Fischhoff request under 37 CFR § 1.641(a) (Paper No. 110) that the APJ exercise its discretion and notify the parties that Claims 1-12 of Adang's U.S. Patent 5,380,831, issued January 10, 1995, appear to be unpatentable under 35 U.S.C. § 112, first paragraph (best mode requirement), and set a time period for the parties to take testimony and present related evidence and argument;

dismissing Fischhoff's motion under 37 CFR § 1.635 (Paper No. 118) for an order temporarily staying the interference proceeding under 37 CFR § 1.645(d) in anticipation of an impending decision of the U.S. District Court for the Southern District of California "on a motion for summary judgment that the claims of . . . Adang's . . . U.S. Patent No. 5,380,831 are invalid under 35 U.S.C. § 102(g) because of prior invention by . . . Fischhoff . . ." (Paper No. 118, p. 2, para. I);

dismissing Fischhoff's motion under 37 CFR § 1.635 (Paper No. 127) for an order temporarily staying the interference proceedings under 37 CFR § 1.645(d) pending a decision on appeal to the Federal Circuit of a decision of the U.S. District Court for the Southern District of California granting Monsanto's motion for summary judgment that claims of Adang's U.S. Patent 5,380,831 are invalid under 35 U.S.C. § 102(g) over the prior invention of Fischhoff (Paper No. 127, p. 2, para. I); and

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ordering:

(1) Interference 103,781 "redeclared as Barton
(U.S. Application 07/827,906) or Fischhoff (U.S. Application
08/434,105) v. Adang (U.S. Patent 5,380,831)" (Paper No. 148)
with the following new Count 2:

Count 2

Any one of Claims 1-4, 7, and 15-22 of Barton et al.'s
Application 07/827,906, filed January 30, 1992;

- or -

Any one of Claims 3, 5, and 39-43 of Fischhoff et al.'s
Application 08/434,105, filed May 3, 1995;

- or -

Any one of Claims 1-14 of Adang et al.'s
U.S. Patent 5,380,831, which issued January 10, 1995,
from U.S. Application 08/057,191, filed May 3, 1993.

and Barton's Claims 1-4, 7, and 15-22; Fischhoff's Claims 3, 5,
and 39-43; and Adang's Claims 1-14 designated as corresponding to
new Count 2;

(2) the parties to consider the relationship of the subject
matter defined by Count 2 of this interference to subject matter
claimed in Mycogen's U.S. Patents 6,013,523 and 6,015,891 and
comment thereon;

(3) the parties to specify whether the time for filing
preliminary motions should be extended;

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(4) the parties to specify what additional preliminary motions, if any, and supporting evidence, if any, need be filed in this newly declared interference;

(5) the parties to explain why the additional preliminary motions and supporting evidence specified are necessary to, and should be filed in, this interference proceeding, and

(6) the parties to recommend time periods for filing the specified additional preliminary motions, supporting evidence, oppositions, replies, motions to suppress evidence, etc.

2. Parties's responses to APJ's September 4, 2002, order

A. Adang's REQUEST FOR RECONSIDERATION and RESPONSES RE: THE DECISION ON MOTIONS AND REQUEST (Paper No. 154):

I. alternatively asks the Board to:

require Monsanto to elect the first to invent the subject matter defined by Count 2 as between Barton and Fischhoff;

remand the Barton and Fischhoff applications to a primary examiner to require identification of Fischhoff or Barton as the first to invent the subject matter defined by Count 2 under 37 CFR § 1.78(c); or

declare separate interferences, i.e., Fischhoff v. Adang and Barton v. Adang;

II. asks the Board for leave to file preliminary motions under 37 CFR § 1.633(a) for judgment that:

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Barton is not entitled to a patent containing Barton's claims designated as corresponding to Count 2 in view of Monsanto's alleged violation of 37 CFR § 1.56; and

Fischhoff is not entitled to a patent containing Fischhoff's claims designated as corresponding to Count 2 in view of Monsanto's alleged violation of 37 CFR § 1.56;

III. asks the Board for leave to file a miscellaneous motion under 37 CFR § 1.635 for additional discovery under 37 CFR § 1.687(c) relating to Monsanto's alleged violation of 37 CFR § 1.56;

IV. asks the Board for leave to file a preliminary motion under 37 CFR § 1.633(a) for judgment that Barton's Claims 21 and 22 are unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement);

V. asks the Board for leave to file a preliminary motion under 37 CFR § 1.633(a) for judgment that Fischhoff's Claim 40 is unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement);

VI. asks the Board for leave to file a preliminary motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by excluding Adang's Claims 2, 3, 5-7, 9, 10, 13 and 14 from Count 2;

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VII. asks the Board for leave to file a renewed or amended miscellaneous motion under 37 CFR § 1.635 for additional discovery under 37 CFR § 1.687(c) relating to derivation of invention; and

VIII. asks the Board to refrain from adding Mycogen's U.S. Patents 6,013,523 and 6,015,891 to this interference.

B. Fischhoff's and Barton's Joint Comments Requesting Addition of Adang Patents to Interference (Paper No. 157):

I. asks the Board to exercise discretion under 37 CFR § 1.642 and:

a. add Adang et al., U.S. Patent 6,015,891 (Adang '891), issued January 18, 2000, to this interference, and designate Claims 1-6 thereof as corresponding to Count 2;

b. add Adang et al., U.S. Patent 6,013,523 (Adang '523), issued January 11, 2000, to this interference, and designate Claims 1-4 thereof as corresponding to Count 2; and

c. grant Fischhoff and/or Barton leave to brief for final hearing issues relating to the patentability of Claims 1-6 of Adang's '891 patent and Claims 1-4 of Adang's '523 patent under 35 U.S.C. §§ 102, 103, and 112, which had been raised in preliminary motions with respect to claims of Adang's involved U.S. Patent 5,380,831, issued January 10, 1995,

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designated as corresponding to Count 2 and deferred to final hearing (Paper No. 148); and

II. does not ask for leave to file any new preliminary motions.

3. Replies to responses to APJ's September 4, 2002, order

A. Adang's Request to Strike Monsanto Motion or Set Period for Response Thereto (Paper No. 160) asks the Board alternatively to:

I. strike Fischhoff and Barton's Joint Comments Requesting Addition of Adang Patents to Interference (Paper No. 157); or

II. set a period for Adang to respond to Fischhoff's and Barton's Joint Comments Requesting Addition of Adang Patents to Interference (Paper No. 157);

B. Fischhoff's and Barton's Joint Comments Concerning Adang's Request for Reconsideration and Responses Re: the Decision on Motions and Requests (Paper No. 161) asks the Board to:

I. dismiss Adang's request for reconsideration; and

II. deny Adang's requests for leave to file every preliminary motion it proposes to file but for Adang's request for leave to file a motion under 37 CFR § 1.633(a) to declare

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Barton's Claims 21 and 22 unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement);

III. set a time period for Barton to file its preliminary statement; and

IV. add Adang's U.S. Patents 6,015,891 and 6,013,523 to this interference;

C. Adang's Observations Regarding Monsanto's Joint Comments (Paper No. 162) asks the Board to:

I. strike Fischhoff's and Barton's Joint Comments Concerning Adang's Request for Reconsideration and Responses Re: the Decision on Motions and Requests (Paper No. 161); and

II. set a time period for Adang to file a supplemental preliminary statement.

4. Discussion of parties' responses, requests and observations

A. Adang alternatively asks the Board to require Monsanto to designate Fischhoff or Barton as first to invent the subject matter of Count 2, remand the involved Fischhoff and Barton applications to a primary examiner to require Monsanto to state the prior inventor of the conflicting subject matter both claim, or declare separate interferences of Fischhoff v. Adang and Barton v. Adang. Adang's requests are DENIED.

Barton v. Adang, 162 F.3d 1140, 49 USPQ2d 1128 (Fed. Cir. 1998), teaches at 1146, 49 USPQ2d at 1134:

[A]t the time that Monsanto was forced to make an election between the Barton et al. and the Fischhoff et al. applications, it was not clear what the content of the final count would be or what proofs on dates of conception and reduction to practice Adang et al. would seek to establish. Also, if the final count as decided by the Board excluded subject matter disclosed in Barton et al., but not Fischhoff et al., Monsanto loses arguably patentable subject matter by early dismissal of Barton et al.

At this stage of the proceedings, Monsanto could not determine which application, either Barton et al. or Fischhoff et al., would be the best evidence to establish priority. We hold that Monsanto has shown "good cause" to continue the interference on both its applications until the preliminary motions to finalize the count are decided by the Board and discovery is complete.

Given Adang's request to file a preliminary motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by excluding Adang's Claims 2, 3, 5-7, 9, 10, 13 and 14 from Count 2, Barton's request to set a time period for filing its preliminary statement, and Adang's request to set a time period for supplementing its preliminary statement, Adang itself appears unsatisfied that either Count 2 which presently defines the interfering subject matter or the scope of discovery required to make its case for priority of invention has been finalized. Accordingly, there remains "good cause" for Monsanto to continue the interference on both its applications.

Moreover, Adang's alternative request to either remand both of the Fischhoff and Barton applications commonly assigned

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to Monsanto to the primary examiner for action under 37 CFR § 1.78(c) or declare separate interferences between Adang's patent and each of Monsanto's applications would needlessly delay final resolution of priority of the invention of Count 2 between Adang and Monsanto (either Fischhoff or Barton) without significant benefit. Accordingly, each of Adang's alternative requests are DENIED.

B. Next, Adang asks for leave to file preliminary motions under 37 CFR § 1.633(a) for judgment that all of Fischhoff's and Barton's claims designated as corresponding to Count 2 are unpatentable due to the common assignee Monsanto's purported violations of 37 CFR § 1.56. Adang's requests are DENIED.

First, during the preliminary motion stage of Fischhoff v. Adang, long before the decision in Barton v. Adang, 162 F.3d 1140, 49 USPQ2d 1128 (Fed. Cir. 1998), Adang filed Preliminary Motion 3 (Paper No. 47) on May 8, 1997. Therein, Adang moved "under 37 CFR § 1.633(a) for judgment against party Fischhoff et al. Claims 3, 5, 39, 40, and 41-43, all designated to correspond to the current count, if deposition and documentary discovery should show that the claims are not patentable to Fischhoff et al. in view of the possible prior invention of Barton et al." (Paper No. 47, pp. 1-2). In support of its motion

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filed May 8, 1997, Adang relied the following material facts
(Paper No. 47, pp. 2-4):

1. The declaration of interference 103,781 [dated November 7, 1996,] identified Barton et al., Fischhoff et al. and Adang et al. as parties to the interference.

2. Monsanto is the assignee of the involved Barton et al. and Fischhoff et al. applications.

3. In an Order dated January 17, 1997, the APJ ordered Monsanto (as common assignee of Barton et al. and Fischhoff et al.) to name the prior inventive entity of the current count as between Barton et al. and Fischhoff et al.

4. In a paper styled "Response Of The Common Assignee Monsanto To The Paper Mailed January 17, 1997," served on February 18, 1997, Monsanto named party Fischhoff et al. as prior inventor of the subject matter of the current count.

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6. Several civil actions are currently pending between Monsanto and Mycogen. Two of these civil actions are:

Case No. 950653 J (LSP) MYCOGEN PLANT SCIENCE, INCORPORATED and AGRIGENETICS, INCORPORATED v. MONSANTO COMPANY, pending in the Southern District of California (the "California action");

Case No. 96-133 (RRM), MONSANTO COMPANY v. MYCOGEN PLANT SCIENCE, INC. and CIBA-GEIGY CORPORATION (SEED DIVISION), pending in the District of Delaware (the "Delaware action").

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10. In the California action, only partial discovery has so far been obtained pertaining to inventive acts of party Adang et al., party Fischhoff et al., and Barton et al.

11. The discovery documents received thus far in the California action have not been sufficiently scrutinized to enable the party Adang et al. to reach any definitive conclusions regarding the relative dates of invention as between Barton et al. and Fischhoff et al.

12. Rule 30(b)(6) depositions of Monsanto and Mycogen as to conception and reduction to practice (but not as to diligence) have been concluded.

13. Adang et al. has not yet deposed Barton or Miller or other witnesses relative to the dates of invention of Barton et al. versus Fischhoff et al.

Based on the statement of material facts in Adang's Preliminary Motion 3 (Paper No. 47, pp. 2-4), Adang appears to have understood during the original preliminary motion stage of this interference that (1) claims in Fischhoff's and Barton's involved applications were directed to the same patentable invention, and (2) Fischhoff's and Barton's involved applications were commonly assigned to Monsanto Company. These material facts have not changed since the original period set for filing preliminary motions expired. Adang has not explained why it should be granted leave to file new preliminary motions to have Fischhoff's and Barton's claims designated as corresponding to count judged unpatentable due to common assignee Monsanto's purported violations of 37 CFR § 1.56 even though its previous opportunities to do so had lapsed. Adang has not explained why its earlier inaction now should be excused.

Moreover, Adang has not pointed to any action or inaction by Monsanto before the U.S. Patent and Trademark Office, or any other information, which prima facie suggests that "fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct." 37 CFR § 1.56(a). This interference was first declared on November 7, 1996, with Barton et al. and Fischhoff et al. as junior parties and Adang et al. as senior party, even though Office records indicate that (1) Agracetus, Inc., executed an assignment of its interest in involved Barton et al., U.S. Application 07/827,906, to Monsanto Company on May 21, 1996, and that assignment was recorded in the Office on October 15, 1996; and (2) on November 25, 1996, as required under 37 CFR § 1.602(b) within 20 days after the declaration was declared, Monsanto notified the Office that (Paper No. 9, p. 1):

[I]t is the owner of the entire right, title and interest in both the involved application Serial No. 07/827,906 of the party Barton et al. and the involved application Serial No. 08/434,105 of the party Fischhoff et al. Monsanto Company is also the owner of the entire right, title and interest in the prior applications for which benefit was accorded to the parties Barton et al. and Fischhoff et al. in the declaration of interference mailed November 7, 1996.

In its November 25, 1996, notification, Monsanto presented the following arguments as good cause for continuing the interference (Paper No. 9, pp. 2-4):

Monsanto Company submits that good cause exists for continuing the present interference among the parties Adang et al., Fischhoff et al. and Barton et al. Notwithstanding the present common ownership of the involved applications of Fischhoff et al. and Barton et al. Good cause exists because of inherent legal uncertainties in determining priority of invention for involved subject matter.

. . . Monsanto Company acquired its rights in the Barton et al. application subject matter with its acquisition of the assets of Agracetus in about April, 1996, and was thus not involved in the making of the invention or preparation and prosecution of the Barton et al. applications leading to declaration of the interference.

. . . [T]he decision in Burroughs Wellcome [Co.] v. Barr Laboratories[.] Inc., [40 F.3d 1223,] 32 USPQ2d 1915 (Fed. Cir. 1994) . . . illustrates the extreme sensitivity to priority determinations of the precise content of the count in interference. In the present interference, the content of the count has not as yet been addressed in preliminary motions.

Because Monsanto Company was not involved in and did not control the approximately seven years of prosecution of the involved Barton et al. application leading up to the present interference, because the precise content of the count in interference is subject to change following preliminary motions, and because of inherent legal uncertainties involved in priority determinations in biotechnology, good cause is believed to exist for continuing the interference as presently drawn. Alternatively stated, no good cause exists for requiring the present common owner of two involved applications to precipitously disclaim priority for the inventive subject matter of one involved application in favor of another, and to proceed with the interference with reference only to one application.

The CAFC considered substantially the same arguments on Monsanto's appeal of the Board's final decision dismissing Barton as a party to this interference. The court reversed and

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remanded. Barton v. Adang, 162 F.3d 1140, 1146, 49 USPQ2d 1128, 1134 (Fed. Cir. 1998). In that light, and considering not only Adang's failure to raise the issue during the original preliminary motion stage of this interference but also substantial evidence of record inconsistent with Adang's present argument, leave for Adang to file preliminary motions under 37 CFR § 1.633(a) based on Monsanto's alleged violation of duties under 37 CFR § 1.56 are at this time DENIED.

C. Furthermore, the record does not indicate that the interests of justice are better served by granting Adang an unlimited license to search for fraud. Neither a patent applicant's bad faith nor misconduct may be presumed. Accordingly, Adang's request for leave to file a miscellaneous motion under 37 CFR § 1.635 for additional discovery under 37 CFR § 1.687(c) relating to Monsanto's alleged violation of 37 CFR § 1.56 is at this time DENIED.

D. Adang asks for leave to file a preliminary motion under 37 CFR § 1.633(a) for judgment that Claims 21 and 22 of Barton's Application 07/827,906, filed January 30, 1992, to which new Count 2 of this interference is alternatively drawn, are unpatentable under 35 U.S.C. § 112, first paragraph, for noncompliance with its written description requirement. Because this interference was ordered redeclared with Barton reinstated

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as a junior party, and the interfering subject matter is now defined by new Count 2 alternatively directed to the subject matter defined by Claim 21 or 22 of Barton's Application 07/827,906, Adang's request is warranted.

Adang also asks for leave to file a preliminary motion under 37 CFR § 1.633(a) for judgment that Claim 40 of Fischhoff's Application 08/434,105, filed May 3, 1995, to which Count 2 of this interference is also alternatively drawn, is unpatentable under 35 U.S.C. § 112, first paragraph, again for noncompliance with its written description requirement. Adang's request to file this motion criticizing the patentability of a claim which originally was and remains designated as corresponding to the interference count under 35 U.S.C. § 112, first paragraph (written description requirement), long after the original period set for filing preliminary motions has ended, does not appear to be justified by either Barton's reinstatement as a junior party to this interference, the scope of new Count 2, or the principles stated in Enzo Biochem, Inc. v. Gen-Probe, Inc., 296 F.3d 1316, 63 USPQ2d 1609 (Fed. Cir. 2002) (Enzo). Enzo differs from precedent in its acceptance of public deposits of biological materials in satisfaction of the written description requirement of 35 U.S.C. § 112, first paragraph. Absent a public deposit of the claimed biological materials, Enzo and the precedent it

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cites; i.e., Reagents of the University of California v. Eli Lilly & Co., 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997); Fiers v. Revel, 984 F.2d 1164, 25 USPQ2d 1601 (Fed. Cir. 1993); and Amgen, Inc. v. Chugai Pharmaceutical Co., 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); instruct that biological material is preferably defined in terms of its chemical structure, formula, and name.

Accordingly, Adang's request for leave to file a preliminary motion under 37 CFR § 1.633(a) for judgment that Barton's Claims 21 and 22 are unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement), is GRANTED. However, Adang's request for leave to file a preliminary motion under 37 CFR § 1.633(a) for judgment that Fischhoff's Claim 40 is unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement), is DENIED.

An independent time period for filing said motion is set to expire thirty (30) days from the date of this decision and order. Monsanto has forty-five (45) days from the date of this decision and order to reply to Adang's motion.

E. Adang asks for leave to file a preliminary motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by excluding Claims 2, 3, 5-7, 9, 10, 13 and 14 of senior party Adang's U.S. Patent 5,380,831 from this interference. In that

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Claims 1-14 stand designated as corresponding to Count 2, and continuously have been designated as corresponding to an interference count drawn to the subject matter of Claim 1 of Adang's U.S. Patent 5,380,831, from the date this interference was declared, Adang's request does not appear to be justified by Barton's reinstatement as a junior party to this interference or the scope of new Count 2.

Adang argues that the preliminary motion is warranted at this time because (Paper No. 154, p. 14):

[The Board's] DECISION does not properly consider the scope of the various claims that are included in the definition of Count 2. Moreover, it appears the DECISION may have overlooked certain principles relating to the initial scope of interference counts.

More particularly, Adang explains (Paper No. 154, p. 14) (emphasis added):

The present breadth of Count 2 is not required by the current interference rules and, in any event, is subject to redefinition by preliminary motions. Adang believes the proper scope of the count and designation of claims can be most efficiently and effectively addressed during the extended preliminary motion period. In the event such a period is not set, Adang hereby requests authorization to file an appropriate supplemental request for reconsideration directed to the scope of the count and the designation of claims corresponding thereto.

It appears that Adang's claims 2, 3, 5-7, 9, 10, 13, and 14 do not define the same patentable invention as the other claims included in the definition of Count 2. Adang intends to file a motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by substituting Count 2 with a substitute count that is not defined by Adang claims 2, 3, 5-7, 9, 10,

13, 1nd 14. The motion will also designate Adang's claims 2, 3, 5-7, 9, 10, 13, and 14 as not corresponding to the substitute count. Adang presently intends to rely on the disclosures of the parties' involved patent and applications, as well as possible declaration evidence in support of this motion.

Adang's request and supporting arguments do not recognize that Count 1 of the interference, originally declared with Barton and Fischhoff as junior parties and Adang as senior party, and present Count 2 of this interference redeclared again with Barton and Fischhoff as junior parties and Adang as senior party are directed to the same patentable invention. The subject matter of old Count 1 was described in language identical to that of Claim 1 of Adang's U.S. Patent 5,380,831. New Count 2 is alternatively directed to the invention of Claim 1 of Adang's U.S. Patent 5,380,831. In the interference, whether as originally declared with Count 1 defining the interfering subject matter, or as redeclared with Count 2 defining the interfering subject matter, Claims 1-14 of Adang's U.S. Patent 5,380,831 have continuously been, and remain, designated as corresponding to the count. Moreover, Claims 2, 3, 5-7, 9, and 10 depend from, and thus further limit, Claim 1 of Adang's U.S. Patent 5,380,831.

Accordingly, Adang could have presented a preliminary motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by excluding Claims 2, 3, 5-7, 9, 10, 13 and 14 of senior party Adang's U.S. Patent 5,380,831 from this interference in the

original time period set for filing preliminary motions. Adang did not do so. Rather, Adang was satisfied to file its Preliminary Motion 1 (Paper No. 47) under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by substituting Proposed Substitute Count 2 for existing Count 1. That motion was denied (Paper No. 148). Adang's explanation why it should be granted leave to file a preliminary motion under 37 CFR § 1.633(c)(1) that it could have, but did not, file in the time period set does not excuse its earlier inaction. Leave to file the motion under 37 CFR § 1.633(c)(1) is at this time DENIED.

F. Adang does not appear to have filed an earlier motion under 37 CFR § 1.635 "for discovery under 37 CFR § 1.687(c) re: Derivation of Invention" (Paper No. 154). Accordingly, at this time Adang's request for leave to renew or amend an earlier filed motion for additional discovery regarding derivation of invention is DENIED.

G. Adang submits that MycoGen's U.S. Patents 6,013,523, patented January 11, 2000, and 6,015,891, patented January 18, 2000, should not be added to this interference because their addition to this interference is both unwarranted and inappropriate (Paper No. 154, p. 16). Adang correctly argues that "Adang's terminal disclaimers in the '523 and '891 patents do not constitute an admission that the '523 and '891 patent

claims define the same patentable invention as the Adang '831 patent claims included in the definition of Count 2" (Paper No. 154, p. 16). However, irrespective of the fact that Mycogen's terminal disclaimers were filed in its patents to overcome obviousness-type double-patenting rejections of the inventions claimed in view of the subject matter claimed in one or more of Mycogen's U.S. Patents 5,380,831, 5,567,600, and 5,567,862, the APJ's DECISION AND ORDER ON PRELIMINARY AND MISCELLANEOUS MOTIONS AND REQUESTS entered September 4, 2002 (Paper No. 148), and FISCHHOFF ET AL.'S AND BARTON ET AL.'S JOINT COMMENTS REQUESTING ADDITION OF ADANG PATENTS TO INTERFERENCE filed November 29, 2002 (Paper No. 157), support a conclusion that the claims in Mycogen's U.S. Patents 6,013,523 and 6,015,891 are drawn to the same, presumably patentable, invention as claims designated as corresponding to Count 2 of this interference without traverse. Nevertheless, there are substantial reasons why Mycogen's U.S. Patents 6,013,523 and 6,015,891 will not be added to this interference.

In each of Mycogen's U.S. Patent 6,013,523, issued January 11, 2000, and U.S. Patent 6,015,891, issued January 18, 2000, Mycogen filed a terminal disclaimer to overcome an obviousness-type double-patenting rejection in view of one or more claims of Mycogen's U.S. Patents 5,380,831, 5,567,600, and

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5,567,862. The terminal disclaimer filed in U.S. Patent 6,013,523 (Application 08/704,966, filed August 29, 1996 (Paper No. 25, entered no later than June 1, 1999), reads:

The owner of 100% interest in the instant application, Mycogen Plant Science, Inc., hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 for U.S. Patent No. 5,567,862, issued on October 22, 1996. . . .

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent No. 5,567,862 in the event that the '862 patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

The terminal disclaimer filed in U.S. Patent 6,015,891 (Application 08/705,438, filed August 29, 1996 (Paper No. 23, entered no later than May 12, 1999)) reads:

The owner of 100% interest in the instant application, Mycogen Plant Science, Inc., hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 for U.S. Patent No. 5,380,831, issued January 10, 1995 and U.S. Patent No. 5,567,600, issued on October 22, 1996. . . .

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the

instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent No. 5,380,831 and 5,567,600 in the event that the '831 and '600 patents expires [sic] for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

The legal effect of the terminal disclaimers filed in U.S. Patents 6,015,891 and 6,013,523 is unclear under 37 CFR § 1.321. Rule 321(a)(2) provides that "[a] disclaimer which is not a disclaimer of a . . . term will be refused recordation" Rule 321(b)(2) and (c)(1) provides:

(b) An applicant or assignee may disclaim . . . the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

• • • •

(2) Specify the portion of the term of the patent being disclaimed;

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in an application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section

The terminal disclaimer filed in each of Mycogen's U.S. Patents 6,013,523 and 6,015,891 "does not disclaim the terminal part of any patent granted on the instant application that would extend

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to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of . . . [one or more of its patents] in the event that . . . [said one or more patents] is found invalid by a court of competent jurisdiction"

Moreover, on September 8, 1999, prior to filing its conditional terminal disclaimers to obviate obvious-type double-patenting rejections in the applications, after which U.S. Patent 6,013,523 issued January 11, 2000, and U.S. Patent 6,015,891 issued January 18, 2000, the U.S. District Court for the District of Delaware entered a revised order (Mycogen Plant Science, Inc. v. Monsanto Co., 61 F. Supp. 2d 199 (D. Del. 1999)) that the claims of Mycogen's U.S. Patents 5,567,862 and 5,567,600 were invalid under § 102(g) and/or 103 and 35 U.S.C. § 112, first paragraph (lack of enablement). It is unclear from the records if and when Mycogen informed the examiner or examiners of the applications from which U.S. Patents 6,013,523 and 6,015,891 containing the conditional terminal disclaimers issued that Mycogen's U.S. Patents 5,567,862 and 5,567,600 had been held invalid under 35 U.S.C. § 102(g) and/or 103 or 35 U.S.C. § 112, first paragraph (lack of enablement), by a court of competent jurisdiction.

On November 10, 1999, prior to filing its conditional terminal disclaimers to obviate obvious-type double-patenting

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rejections in the applications, from which U.S. Patent 6,013,523 issued January 11, 2000, and U.S. Patent 6,015,891 issued January 18, 2000; the U.S. District Court for the Southern District of California entered an order (Mycogen Plant Science, Inc. v. Monsanto Co., No. 95-CV-653 (S.D. Cal. Nov. 10, 1999) (Paper No. 127, Exh. A)) that Claims 1-12 of Mycogen's U.S. Patent 5,380,831 were invalid under 35 U.S.C. § 102(g) and/or 103 because Monsanto invented the subject matter thereof before Mycogen, as determined by the U.S. District Court for the District of Delaware (Mycogen Plant Science, Inc. v. Monsanto Co., 61 F. Supp. 2d 199 (D. Del. 1999)). It is unclear from the records if and when Mycogen informed the examiner or examiners of the applications from which U.S. Patents 6,013,523 and 6,015,891 containing the conditional terminal disclaimers that Claims 1-12 of Mycogen's U.S. Patent 5,380,831 had been held invalid under 35 U.S.C. § 102(g) and/or 103 by a court of competent jurisdiction.

Finally, Mycogen's U.S. Patents 6,013,523 and 6,015,891 claim synthetic B.t. genes and other biological materials and methods of using biological materials containing synthetic B.t. genes. In its REQUEST FOR RECONSIDERATION and RESPONSES RE: THE DECISION ON MOTIONS AND REQUESTS (Paper No. 154), Mycogen raises the issue whether the specification of Barton's involved

application provides an adequate written description of the full scope of biological materials Barton claims as required under 35 U.S.C. § 112, first paragraph, in light of Enzo Biochem, Inc. v. Gen-Probe, Inc., 296 F.3d 1316, 63 USPQ2d 1609 (Fed. Cir. 2002) (Enzo). Needless to say, because Mycogen's U.S. Patents 6,013,523 and 6,015,891 claim synthetic B.t. genes and other biological materials and methods of using biological materials containing synthetic B.t. genes, new issues whether the full scope of the subject matter they claim is adequately described in their respective supporting specifications under 35 U.S.C. § 112, first paragraph, may be raised.

While the evidence of record supports a conclusion that their claims are directed to the same invention as Count 1 of this interference, new issues may be raised as to the patentability of the subject matter claimed. Accordingly, at this time, Fischhoff's invitation to add Mycogen's U.S. Patents 6,013,523 and 6,015,891 to this interference is DISMISSED.

5. Conclusions

Adang's request to require Monsanto to designate Fischhoff or Barton as first to invent the subject matter of Count 2 (Paper No. 154) is DENIED.

Adang's requests for leave to file preliminary motions under 37 CFR § 1.633(a) for judgment that all Fischhoff and Barton

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claims designated as corresponding to Count 2 are unpatentable due to common assignee Monsanto's purported violations of 37 CFR § 1.56 (Paper No. 154) are DENIED.

Adang's request for leave to file a miscellaneous motion under 37 CFR § 1.635 for additional discovery under 37 CFR § 1,687(c) relating to Monsanto's purported violation of 37 CFR § 1.56 (Paper No. 154) is DENIED.

Adang's request for leave to file a preliminary motion under 37 CFR § 1,633(a) for judgment that Claims 21 and 22 of Barton's Application 07/827,906, filed January 30, 1992, are unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement) (Paper No. 154), is GRANTED.

Adang's request for leave to file a preliminary motion under 37 CFR § 1,633(a) for judgment that Claim 40 of Fischhoff's Application 08/827,906, filed May 3, 1995, is unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement) (Paper No. 154), is DENIED.

Adang's request for leave to file a preliminary motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by excluding Claims 2, 3, 5-7, 9, 10, 13 and 14 of Adang's U.S. Patent 5,380,831 from this interference (Paper No. 154) is DENIED.

Adang's request for leave to renew or amend an earlier filed motion under 37 CFR § 1.635 "for discovery under 37 CFR § 1.687(c) Re: Derivation of Invention" (Paper No. 154) is DENIED.

Fischhoff's invitation to add Mycogen's U.S. Patents 6,013,523 and 6,015,891 to this interference (Paper No. 157) is DISMISSED.

6. Order

The parties to this interference have been involved in a number of district and appellate court proceedings, including the aforementioned terminated district court proceeding in the U.S. District Court for the District of Delaware (Mycogen Plant Science, Inc. v. Monsanto Co., No. 96-505 (D. Del. 1998)) brought by Mycogen Plant Science, Inc., and Agrigenetics Inc. against Monsanto Co., DeKalb Genetics Corp., and Delta and Pine Land Co. for infringement of two Mycogen patents (Adang et al., U.S. Patent 5,567,862, entitled "Synthetic Insecticidal Crystal Protein Gene," which issued October 22, 1996, from U.S. Application 08/369,839, filed January 6, 1995, and Adang et al., U.S. Patent 5,567,600, entitled "Synthetic Insecticidal Crystal Protein Gene," which issued October 22, 1996, from U.S. Application 08/369,835, filed January 6, 1995); and the district court proceeding in the U.S. District Court for the Southern

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District of California (Mycogen Plant Sci., Inc. v. Monsanto Co., No. 95-CV-653 (S.D. Cal. 1999) brought by Mycogen Plant Science, Inc. and Agrigenetics Inc. against Monsanto Company for infringement of plaintiff's patent (Adang et al., U.S. Patent 5,380,831, issued January 10, 1995, from U.S. Application 08/057,191, filed May 3, 1993). The parties and most of the issues raised in those proceedings are common to this interference proceeding. Moreover, the parties have informed the Board that extensive testimony has been taken by the parties to this interference and discovery has been allowed by the district courts relating to issues common to this proceeding. Evidence, testimony, and exhibits from other proceedings involving the same parties may be introduced in this interference in accordance with 37 CFR §§ 1.671-1.683. Therefore, the time period set for taking additional testimony and discovery relative to the issues presented by this interference is limited as ordered below.

Having considered all the parties requests, invitations, and comments, it is:

ORDERED that the parties to this interference will update the status of the district court proceeding in the U.S. District Court for the Southern District of California (Mycogen Plant Sci., Inc. v. Monsanto Co., No. 95-CV-653 (S.D. Cal. 1999)), brought by Mycogen Plant Science, Inc. and Agrigenetics Inc.

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against Monsanto Company for infringement of Adang's U.S. Patent 5,380,831, issued January 10, 1995, no later than thirty (30) days from the date of this decision and order.

FURTHER ORDERED that Senior Party Adang may file a preliminary motion under 37 CFR § 1.633(a) for judgment that Claims 21 and 22 of Barton's U.S. Application 07/827,906 are unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement);

FURTHER ORDERED that the time period for filing Senior Party Adang's preliminary motion under 37 CFR § 1.633(a) for judgment that Claims 21 and 22 of Barton's U.S. Application 07/827,906 are unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement), is set to expire thirty (30) days from the date of this decision and order, and the time period for Monsanto to file a joint Barton/Fischhoff reply to Adang's preliminary motion under 37 CFR § 1.633(a) for judgment that Claims 21 and 22 of Barton's U.S. Application 07/827,906 are unpatentable under 35 U.S.C. § 112, first paragraph (written description requirement), is set to expire forty-five (45) days from the date of this decision and order;

FURTHER ORDERED that Junior Party Barton may file a preliminary statement under 37 CFR § 1.621(a) and shall file said preliminary statement and notice under 37 CFR § 1.621(b) no later

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than thirty (30) days from the date of this decision and order. Without further order of the Board, within seven (7) days after the date set for filing said preliminary statement, a copy of said preliminary statement shall be served on each opponent who served notice under 37 CFR § 1.621(b);

FURTHER ORDERED that Senior Party Adang and Junior Party Fischhoff may each file a supplemental preliminary statement under 37 CFR § 1.621(a) and shall file said amended preliminary statement and notice thereof under 37 CFR § 1.621(b) no later than thirty (30) days from the date of this decision and order. Without further order of the Board, within seven (7) days after the date set for filing said amended preliminary statement, a copy of said preliminary statement shall be served on each opponent who served notice under 37 CFR § 1.621(b);

FURTHER ORDERED that this interference shall proceed to the priority stage and final hearing on the issue of priority;

FURTHER ORDERED that a time period for taking testimony necessary for the junior parties alleging a date of invention prior to the effective date of the senior party to present their cases-in-chief for priority of invention and file motions under 37 CFR § 1.635 for discovery under 37 CFR § 1.687(c) is set to commence with the date of this decision and order and expire thirty (30) days from the date of this decision and order;

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FURTHER ORDERED that a time period for taking testimony necessary for the senior party alleging a date of invention prior to the junior parties' alleged prior effective date of invention to present its case-in-chief for priority of invention and file motions under 37 CFR § 1.635 for discovery under 37 CFR § 1.687(c) is set to commence with the date of this decision and order and expire thirty (30) days from the date of this decision and order;

FURTHER ORDERED that the time period for the parties to present their respective cases-in-rebuttal is set to expire forty-five (45) days from the date of this decision and order;

FURTHER ORDERED that a time period for the parties to cross-examine an opponent's case-in-chief and/or case-in-rebuttal is set to expire sixty (60) days from the date of this decision and order;

FURTHER ORDERED that Monsanto, the common assignee of both Barton's U.S. Application 07/827,906 and Fischhoff's U.S. Application 08/434,105, is required to designate which applicant, Barton or Fischhoff, was first to invent the subject matter defined by Count 2 no later than sixty (60) days from the date of this decision and order;

FURTHER ORDERED that the time period for the remaining parties to file their respective papers under 37 CFR § 1.640(b)

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indicating the issues to be considered at final hearing is set to expire sixty (60) days from the date of this decision and order;

FURTHER ORDERED that the time period for the remaining parties to serve their opponents with their respective Records and Exhibits in support of their Briefs for Final Hearing under 37 CFR § 1.653 is set to expire sixty (60) days from the date of this decision and order;

FURTHER ORDERED that the time period for the remaining parties to this interference to file their respective Briefs for Final Hearing in accordance with 37 CFR § 1.656 is set to expire ninety (90) days from the date of this decision and order;

FURTHER ORDERED that the time period for the remaining parties to file their respective Records and Exhibits in support of their Briefs for Final Hearing under 37 CFR § 1.653 is set to expire ninety (90) days from the date of this decision and order;

FURTHER ORDERED that the time period for each of the remaining parties to file its reply its opponent's Brief for Final Hearing in accordance with 37 CFR § 1.656 is set to expire one hundred (100) days from the date of this decision and order; and

FURTHER ORDERED that the time period for the remaining parties to file the necessary motions under 37 CFR § 1.635 to

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suppress evidence is set to expire one hundred (100) days from the date of this decision and order.

It is FURTHER ORDERED that no later than one hundred (100) days from the date of this decision and order the remaining parties shall jointly designate a date for the Final Hearing of preliminary and miscellaneous motions, and their cases-in-chief for priority of invention; and

FURTHER ORDERED that, in the event the remaining parties cannot agree on a date for Final Oral Hearing of preliminary and miscellaneous motions and the case-in-chief for priority of invention, a date for Final Oral Hearing shall be set on short notice.

The APJ invites the parties to this interference to expedite this proceeding through its priority stage toward Final Hearing. Should a joint conference with the APJ on any matters raised by, or time period set in, this decision and order be required, the parties may contact Paralegal Specialist Dianne Maggard at (703) 305-4673 to set a time and date therefor.

Teddy S. Gron
TEDDY S. GRON
Administrative Patent Judge

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Attorneys for Junior Party BARTON:

Michael F. Borun, Esq.
Marshall, O'Toole, Gerstein, Murray & Borun
6300 Sears Tower
233 S. Wacker Drive
Chicago, Illinois 60606-6402

Attorneys for Junior Party FISCHHOFF:

Lawrence M. Lavin, Jr., Esq.
Monsanto Agricultural Company
700 Chesterfield Parkway North - BB4F
St. Louis, Missouri 63198

Attorney for Senior Party ADANG:

Oliver R. Ashe, Jr. Esq.
Greenblum & Bernstein, P.L.C.
1941 Roland Clarke Place
Reston, Virginia 20191